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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,597	03/26/2001	Motoki Nakade	450100-03084	7826

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FROMMER LAWRENCE & HAUG  
745 FIFTH AVENUE- 10TH FL.  
NEW YORK, NY 10151

EXAMINER
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HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
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3621

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/08/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/817,597

Applicant(s)

NAKADE ET AL.

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4,7,8 and 10-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,7,8 and 10-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Status of Claims***

1. Claims 1-4, 7, 8 and 10-22 have been examined.

***Response to Arguments***

2. Applicant's arguments with respect to claims 1-4, 7, 8 and 10-22 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 10, 11 and 13-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 10 and 11 are directed to consideration. However, claim 1 is silent the term "consideration" therefore it is not clear to one of ordinary how determining and/or paying consideration relates to Applicant's claimed communication service method. Further, claims 10 and 11 do not detail what

Applicant regards as "consideration", who receives it and for what reason (*In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989)).

Claim 13 recites changing a third image signal "in sequence at every series of the connection, at every predetermined period of time". According to claim 1, from which claim 13 depends the third signal was delivered to a user, hence it cannot be updated for future use. Further, if a third signal were changing as Applicant purports then the user would never receive the intended ad as it would change at each connection along the internet backbone. Claim 19 is also rejected as it recites similar language.

Claim 14 recites "receiving means for receiving a first image data *that was received* from one of said plurality of connected communication terminal apparatus' utilized by a first user" (emphasis added). To one of ordinary skill the structure of the claimed apparatus is unclear as in order for the receiving means to receive an image previously received (i.e. stored) by another device, for example, claim 14 would require storing means at the terminal apparatus for first receiving the image and transmitting means for sending the stored (i.e. received image) to the receiving means (*In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989)).

Claims 15-22 are also rejected as each depends from claim 14.

Claim 15 recites the limitation "said second image data selected beforehand by each user" in lines 3 and 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 16 is also rejected as it depends from claim 15.

Claim 17 recites "said connecting means connects said plurality of communication terminal apparatus in a state in which *it is possible* to transmit..." (emphasis added). However, claim 17 is directed to an apparatus. It has been held that such a claim is indefinite and limitations that express how a structure may perform will not distinguish the claimed structure from the teachings of the prior art (*In re Collier*, 158 USPQ 266 (CCPA 1968); MPEP 2100-8, first column).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims rejected under 35 U.S.C. 103(a) as being unpatentable over Nachom, U.S. Patent No. 7,072,856.

As per claims 1-4, 7, 8, 12-19 and 22, Nachom teaches:

- connecting a plurality of communication terminals to each other and transmitting signals between said terminals (figures 1 and 2)

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- superposing a stored second advertisement image over a first image and transmitting the superposed image to a user (figure 2; column 5, lines 10-33)
- transmitting advertisements to users of said terminals (figure 2; column 5, lines 10-33) and providing information to said users in response to a demand from said users (column 5, lines 33-43)
- displaying a transaction environment to the users (column/line 5/43-6/6)
- sending the superposed image based on the first user (advertiser) and a second user (consumer) (column/line 5/10-6/44)

Nachom teaches transmitting data over the internet (column 4, lines 50-61).

Therefore, the prior art at least suggests transmitting audio and image signals as the internet supports the transmitting and playing of MPEG, GIF, JPEG, and MP3 files.

As per claim 2, Nachom teach a user completing a transaction at a second site accessed by clicking on a pop-up ad (abstract; figure 2) hence the prior art teaches selected a product.

As per claims 3, 4, 7, 8 and 18, data stored in memory that does not affect a claimed method or apparatus does not distinguish the claims from the prior art (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01). Similarly [claims 7 and 8], how stored data in memory is arranged for display does not

distinguish the claims from the prior art (*In re Seid*, 161 F.2d 229, 231, 73 USPQ 431, 433 (CCPA 1947)).

As per claim 13 websites that sell multiple products are old and well known (i.e. Amazon.com) hence as Nachom broadly applies his system to companies that sell products over the internet (i.e. www.asite.com and www.site.com- column 5, lines 25-50) it would have been obvious to use the Nachom teaching to sell multiple products.

7. Claims 10, 11, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nachom, U.S. Patent No. 7,072,856 in view of Logan et al., U.S. Patent 5,721,827.

As per claims 10, 11, 20 and 21, Nachom teaches displaying ads to a user (figure 2). However, Nachom does not specifically recite compensating a user for viewing an ad. Logan et al. teach compensating a user for viewing an ad (abstract). Logan et al. also teach targeting ads to users based on user preferences (column/line 9/12-10/5). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Nachom and Logan et al. in order to increase the likelihood that a user will respond to the ad ('856, column 5, lines 40-42).

**Conclusion**

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Merriman et al. teach audio teach ads as audio and video files (e.g. GIF, JPEG)

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

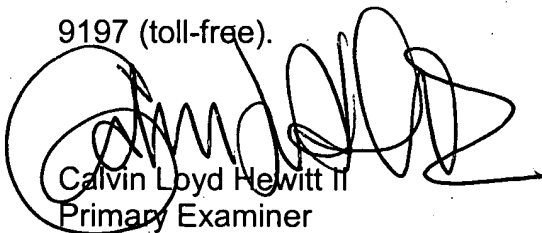
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.



10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://paired.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Calvin Loyd Hewitt II  
Primary Examiner

March 4, 2007